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JUL 18 2003

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of	:
COFFIN et al	:
Serial No. 09/762,098	: DECISION ON PETITION
371 Filing Date: 2 February 2001	:
Attorney Docket No. 117-340	:

This letter is in response to the Contingent Petition under 37 CFR 1.181 filed 16 August 2002.

BACKGROUND

This application was filed on 2 February 2001, under 35 U.S.C. 371 as the national stage filing of PCT/GB99/02547, filed 3 August 1999, which claims priority to Great Britain serial number 9816856.0, filed 3 August 1998.

A review of the file history shows that original claims 1-16 were directed a process for propagating a mutant herpes virus, cell lines as defined by various stages of the process, the virus so produced, and a pharmaceutical composition so produced.

A preliminary amendment filed 20 June 2001 amended some claims' dependency to correspond with US practice, cancelled claim 13 and added claims 17-27.

On 16 May 2002, the Office mailed Paper No. 8, which contained a six-way Restriction Requirement, dividing the claims into groups as follows:

- Group I: Claims 1-12, 27, drawn to a process for propagating a mutant herpes virus and a composition produced by the process.
- Group II, claims 14, 19-20 and 22 drawn to a cell line
- Group III, claims 15, 19, 21, 22 drawn to another cell line
- Group IV, claim 16, drawn to another cell line
- Group V, claims 17-25 drawn to another cell line
- Group VI, claim 26 drawn to a virus.

An election of species was also set forth.

In Paper No. 11, Applicants elected Group I, and species Equine herpes virus gene 12 and HSV ICP4 with traverse. Applicants also filed a Petition under 37 CFR 1.181, as paper No. 12, to be considered in the event that the restriction requirement was not withdrawn.

On 6 November 2002, the Office mailed a non-final action as Paper No. 13. Applicants' election and traversal was acknowledged. The Examiner found the arguments not persuasive, in view of the fact that the argued limitations argued were not present in the claims as pending. The Restriction Requirement was made FINAL.

On 6 May 2003, Applicants filed an amendment which cancelled all claims 11-27 directed to the non-elected invention. Applicants also added new claims 28-58 directed to the elected invention.

DISCUSSION

The petition, as filed, was premature in that it was filed prior to the examiner making the restriction requirement final and is dismissed for this reason alone. However, the additional comments which follow are also pertinent.

The application, file history and petition have been considered carefully. The petition presents two concerns:

- (1) a request to have the restriction requirement withdrawn.
- (2) a request that the requirement be restated wherein applicants, at their discretion, may change their election.

Each concern will be addressed in turn.

First, the petition provides no reasons as to why the restriction requirement should be withdrawn. It merely asserts that the inventions share unity (page 2, top paragraph of Paper No. 12). The reasoning the petition relies upon appears to be the same as that set before the examiner in the election, Paper No. 11, and already reconsidered by the examiner in Paper No. 13. The arguments state that the inventions share a technical feature which makes a contribution over the prior art and the reference cited by the examiner in the restriction requirement, does not address this contribution. The limitations argued in page 4, second full paragraph to top of page 5, do not appear in the claims as they stood at the time the restriction was made, or when the restriction was made final or as the claims are currently amended. For this reason, the arguments are not persuasive.

With regard to applicant's second request, it is noted that allowing applicants to change invention once a first action on the merits has been completed is generally not permitted. See MPEP 819.

Even if the first and/or second argument were persuasive, the petition appears to be asking for rejoinder of or switch to claims which are no longer pending in the application.

DECISION

The petition is **DISMISSED** for the reasons set forth above.

Should there be any questions with regard to this letter, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, Washington DC 20231 or by telephone at (703) 308-7553 or by facsimile transmission at (703) 305-7230.


for
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